

## **REMARKS**

This paper is presented in response to the Office Action. By this paper, claims 1, 10, 12, 22, 23, 27 and 28 are amended, new claims 37-42 are added, and claims 26 and 33-36 are canceled. Claims 1-25, 27-32, and 37-42 are pending in view of the aforementioned claim amendments and cancellations.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments to the claims and the following remarks. For the convenience and reference of the Examiner, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

Applicants note that the remarks and amendments presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, and amendments are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicants: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicants reserve the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicants, of additional or alternative distinctions between the claims of the present application and any references cited by the Examiner, and/or the merits of additional or alternative arguments.

### **II. Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph**

The Examiner has rejected claims 8, 9, 20, 21, and 27 under 35 U.S.C. § 112, second paragraph as being indefinite. In particular, the Examiner has stated that "Applicant claim an 'RT'. However, a careful reading of the specification yields no explanation of this term."

Applicants note however that paragraphs [0053], [0059] and Figure 9A-2 of U.S. Provisional Application No. 60/410,509 (incorporated by reference into the present application. *See paragraph*

[0001]) clearly indicate that the term “RT” refers to a “retimer.” Nonetheless, Applicants have amended paragraph [0055] of the specification herein to reiterate that “RT” refers to a “retimer.”

In light of the foregoing, Applicants respectfully submit that the rejection of claims 8, 9, 20, 21, and 27 under 35 U.S.C. § 112, second paragraph should be withdrawn.

### **III. Allowable Subject Matter**

The Examiner has indicated that claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Applicants have amended claim 23, from which claim 26 depends, to include all of the limitations of claim 26. In light of the foregoing, Applicants submit that claim 23, and claims 24-28 which depend therefrom, are now in condition for allowance.

### **IV. Rejection of Claims Under 35 U.S.C. § 102(b)**

Applicants respectfully note that a claim is anticipated under 35 U.S.C. § 102(b) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *Manual of Patent Examining Procedure (“MPEP”) § 2131.*

The Examiner has rejected claims 1, 12, 23, 29, 31 and 33 under 35 U.S.C. § 102(a) as being anticipated by over U.S. Patent No. 5,557,437 to Sakai et al. (“*Sakai*”). Inasmuch as claim 33 has been canceled herein, Applicants respectfully submit that the rejection of claim 33 has been rendered moot and should be withdrawn. Similarly, inasmuch as claim 23 has been placed in allowable form as discussed at **III.** above, Applicants respectfully submit that the rejection of claim 23 has also been rendered moot and should be withdrawn. With respect to claims 1, 12, 29 and 31, Applicants respectfully disagree for at least the reasons discussed below.

In support of the rejection of claims 1, 12, 29 and 31, the Examiner offers nothing more than a verbatim recitation of a long passage from *Sakai*. See *Office Action*, pp. 2-4. As is evident from the passage as set forth in the Office Action, the Examiner has failed to specifically identify any correspondence between the elements purportedly disclosed in *Sakai* and the elements recited in rejected claims 1, 12, 29, and 31. As but one example, Applicants respectfully note that the Examiner has failed to identify, with any specificity whatsoever, which element(s) of *Sakai* is/are purported to correspond to the elements “a pass-through port” and “a pass-through path” as recited in original claims 29 and 31, and as also recited in amended claims 1 and 12.

As the foregoing makes clear, the vague rejection stated by the Examiner has left Applicants to guess at which element(s) of *Sakai* the Examiner believes to correspond to the recited elements of claims 1, 12, 29 and 31. This much, Applicants respectfully decline to do, at least because it is the Examiner who bears the burden of establishing that a single prior art reference anticipates the rejected claims.

In view of the foregoing, Applicants respectfully submit that the Examiner has failed to establish that *Sakai* anticipates claims 1, 12, 29 and 31, at least because the Examiner has failed to establish that each and every element as set forth in claims 1, 12, 29 and 31 is found in *Sakai*, because the Examiner has failed to establish that the identical invention is shown in *Sakai* in as complete detail as is contained in claims 1, 12, 29 and 31, and because the Examiner has not established that *Sakai* discloses the elements arranged as required by claims 1, 12, 29 and 31. Applicants thus respectfully submit that the rejection of claims 1, 12, 29, and 31 should be withdrawn.

**V. Rejection of Claims under 35 U.S.C. § 103(a)**

Applicants respectfully note at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

The Examiner has rejected claims 2-7, 10, 11, 13-19, 22, 24, 25, 28, 30, 32, 34 and 35 under 35 U.S.C. § 103(a) as being unpatentable over *Sakai* in view of U.S. Patent Publication No. 2002/0021468 to Kato et al. (“*Kato*”). Inasmuch as claims 34 and 35 have been canceled herein, Applicants respectfully submit that the rejection of claims 34 and 35 has been rendered moot and should be withdrawn. Similarly, inasmuch as claims 24, 25 and 28 have been placed in allowable form as discussed at **III.** above, Applicants respectfully submit that the rejection of claims 24, 25 and 28 has also been rendered moot and should be withdrawn. With respect to claim 2-7, 10, 11, 13-19, 22, 30 and 32, Applicants respectfully disagree for at least the reasons discussed below.

Applicants respectfully submit that insofar as the Examiner has failed to establish that *Sakai* teaches or suggests all the limitations of independent claims 1, 12, 29 and 31, and insofar as the Examiner has not established that *Kato* remedies that defect, the rejection of claims 2-7, 10, 11, 13-19, 22, 30 and 32 under 35 U.S.C. § 103(a), each of which depends from one of claims 1, 12, 29 and 31, lacks an adequate foundation for at least the reasons outlined at **IV.** above.

In light of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 2-7, 10, 11, 13-19, 22, 30 and 32 at least because the Examiner has not established that the references, when combined in the purportedly obvious fashion, teach or suggest all the limitations of those claims. Applicant thus respectfully submits that the rejection of claims 2-7, 10, 11, 13-19, 22, 30 and 32 should be withdrawn.

**VI. New Claims**

Applicants have added new claim 37-42 herein. Support for these claims can be found at least in paragraphs [0011], [0032] and [0061]. Applicants respectfully submit that each of claims 37-42 is allowable at least because independent claims 1, 12 and 23 (from which claims 37-42 variously depend) are allowable as discussed above at **III.** and **IV.**

### **CONCLUSION**

In view of the remarks submitted herein, Applicants respectfully submit that each of the pending claims 1-25, 27-32 and 37-42 in this application is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 7th day of November, 2006.

Respectfully submitted,

/Peter F. Malen, Jr./

Peter F. Malen Jr.  
Attorney for Applicants  
Registration No. 45,576  
**Customer No. 022913**  
Telephone: (801) 533-9800